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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFRY JOVAN PHILYAW

Appeal 2009-015272
Application 10/791,678
Technology Center 2400

Before: HUBERT C. LORIN, JOSEPH A. FISCHETTI, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellant seeks our review under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-36. We reverse, but enter a new ground of rejection under 35 U.S.C. § 103(a). (37 CFR § 41.50(b)).

THE CLAIMED INVENTION

Appellant claims a method and apparatus for accessing a remote location by sensing a machine-resolvable code (Specification 2:5-9). Claim 1 is illustrative of the claimed subject matter:

1. A method of accessing one or more remote locations on a network by sensing a machine-resolvable code, comprising the steps of:

providing a first computer disposed on the network, the first computer being interfactable to an input device for sensing a machine-resolvable code proximate a first location, the first computer running a software application which includes a software identification code unrelated to the machine resolvable code having an association with at least one of the one or more remote locations;

accessing with the first computer a second computer disposed on the network in accordance with routing information provided by the first computer and in response to sensing by the input device the machine-resolvable code proximate the first location;

transferring to the second computer from the first computer at least the software identification code;

storing in an associative database at the second computer associations between software identification codes and ones of the one or more remote locations and operable to have routing information associated with each of the one or more remote locations;

performing a lookup operation at the second computer to match the software identification code with the associated at least one of the one or more remote locations in accordance

with the stored associations to obtain associated remote routing information corresponding to the associated at least one of the one or more remote locations;

returning to the first computer from the second computer the remote routing information of the at least one of the one or more remote locations determined at the second computer to correspond to the software identification code that was transferred from the first computer to the second computer; and

accessing with the first computer the associated at least one of the one or more remote locations according to the returned remote routing information to retrieve remote information from the one of the one or more remote locations associated with the returned remote routing information.

REFERENCE

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Wilz, Sr.	US 6,152,369	Nov. 28, 2000
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REJECTION

The following rejection is before us for review: the Examiner rejected claims 1-36 under 35 U.S.C. § 102(e) over Wilz, Sr.

ISSUES

Did the Examiner err in rejecting claims 1-36 under 35 U.S.C. § 102(e) over Wilz, Sr. as disclosing *sensing a machine-resolvable code on a first computer which includes a software identification code and transferring to a second computer from the first computer at least the software identification code*, since Wilz, Sr. discloses sensing a URL in a bar code that is used to access the URL in the bar code, but which does not disclose transferring any *software identification code*?

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence.

1. Wilz, Sr. discloses a system to connect a first “Access System” computer to a second “Server” computer using scanned barcodes, in that it provides connecting the “Internet Access System to the Internet Server that contains the information resource specified by the scanned DN/PN-encoded or URL-encoded bar code symbol.” (Col. 2 ll. 58-67).
2. Wilz, Sr. discloses utilizing Internet protocols, using “well known TCP/IP networking protocols. In general, the Internet infrastructure comprises Internet Service Providers (ISPs), Network Service Providers (NSPs), routers, telecommunication lines and channels, etc., all well known in the art.” (Col. 10 ll. 28-37).
3. Wilz, Sr. discloses that “[e]ach Internet Web-site Server is assigned a unique TCP/IP address (and Domain Name) on the Internet, and is provided with Internet networking software to support the TCP/IP protocol.” (Col. 11 ll. 3-6).
4. We understand that the Internet uses TCIP/IP protocols which employ domain name servers to resolve URL addresses.
5. We understand it is common for a computer to have recorded in its TCP/IP software files the IP address of a Domain Name Server which is consulted to resolve URL addresses into IP addresses.
6. We further understand that a message sent to a Domain Name Server to resolve a URL includes the IP address of that Domain Name Server in the packet addressing.

7. Wilz, Sr. discloses initiating TCP/IP actions *in response to sensing by the input device the machine-resolvable code*, in that the bar code reader system performs these steps:

(i) read a bar code symbol that has been encoded with the complete URL of an Internet information resource to be accessed; and (ii) affix thereto a prefix code string (i.e., CTR(L)) representative of the Internet browser program command that writes the URL into the information resource "Goto" window of the Internet browser program, and a suffix code string (i.e., RTN) representative of the Internet browser program command that executes a HTTP request on the URL entered into the "Go to" window.

(Col. 13 ll. 25-33).

8. We accept as our own the Examiner's findings as to claims 2 (Answer 6), 4-8 (Answer 7), 11-16 (Answer 8-10), 18, 20-24, and 27-36 (Answer 10-11).
9. Wilz, Sr. discloses *audio* used as a *machine-resolvable code* in that "a large-vocabulary speech recognition subsystem may be integrated within the remote housing 42 so that the user can enter information to the Internet browser by speaking rather than through manual keystroke" (Col. 36 ll. 11-17).
10. We understand that domain name servers contain a database of hostnames/uniform record locator addresses corresponding to IP addresses for those hostnames/URL records.

ANALYSIS

Rejection of Claims 1-36 under Section 102(e)

Independent claims 1 and 17 each recite essentially identical claim requirements, though claim 1 is directed to a method and claim 17 is directed to a system.

Appellant argues “the cited portions of *Wilz* do not disclose that any information is transferred from a first computer to a second computer. The only information that is used is the URL (58), which is encoded within the bar-code. *Wilz* does not teach ‘transferring to the second computer from the first computer at least the software identification code.’” (Appeal Br. 25).

We agree with Appellant. Claim 1 requires two codes: *a machine-resolvable code*, and *a software identification code*. The claim requires the *machine-resolvable code* be sensed at a *first computer* and in claims 1-12 serves no purpose other than to initiate action by the *first computer* to utilize the *software identification code*. The *software identification code* is required to be included in the *first computer running a software application*, and is transferred to a *second computer* which returns *remote routing information* to a *remote location*. We find *Wilz*, Sr. discloses a *first computer* at its “Internet Client System” (FF 1), and a sensed *machine-resolvable code* at its scanned “URL-encoded bar code symbol” (FF 1).

In *Wilz*, Sr. however, the scanned bar code is sensed and is not part of software on the first computer, and is therefore not the *software identification code*. We do not find a *software identification code* in *Wilz*, Sr. that is *transferred to the second computer from the first computer*, as required by the claim, because the only *code* transferred is the *machine-*

resolvable code that was sensed from the bar-code (FF 1). We therefore cannot sustain the rejection of claims 1 and 17 under 35 U.S.C. § 102(e).

Since claims 2-16 and 18-36 depend from claims 1 and 17, and since we cannot sustain the rejection of claims 1 and 17, the rejection of claims 2-16 and 18-36 likewise cannot be sustained.

NEW GROUNDS OF REJECTION

Pursuant to 37 CFR § 41.50(b) we enter a new grounds of rejection for claims 1-36 under 35 U.S.C. § 103(a) over Wilz, Sr.

As to independent claims 1 and 17, we find Wilz, Sr. discloses that its system for connecting a client computer system with a server computer system using, among other things, URL-encoded bar codes scanned at the client system (FF 1) and the well-known infrastructure of the Internet (FF 2) that utilizes TCP/IP communications protocols, uniform record locators, and domain names (FF 3). We understand that standard TCP/IP Internet protocols include a domain name service that translates the URL address (*e.g.*, *www.website.com*) to a numeric IP address (*e.g.*, *192.1.1.1*), and that the domain name service runs on separate servers on the Internet (FF 4). *See, Akamai Technologies, Inc. v Cable & Wireless Internet Services*, 344 F.3d 1186, 1188-1189 (Fed. Cir. 2003) (cited by Appellant, Appeal Br. 12, fn. 67).

Based on these findings and our understanding of common knowledge of one of ordinary skill in the art about the Internet and TCP/IP protocols, we find that it is common for a computer to have recorded in its TCP/IP software files the IP address of a Domain Name Server which is consulted to resolve URL addresses into IP addresses (FF 5). We further understand that a message sent to a Domain Name Server to resolve a URL includes the IP

address of that Domain Name Server in the addressing contained in the packet sent using TCP/IP protocols to the other computer (FF 6).

We therefore find one of ordinary skill in the art would recognize in Wilz, Sr. the disclosure of the common practice of storing a *software identification code* in the form of an IP address of a Domain Name Server in a *first computer* (client system). This DNS server address is unrelated to a URL the DNS server is being asked to resolve in that they identify different *remote systems*. We further find in Wilz, Sr. that the scanning of the bar code causes a *response to sensing by the input device the machine-resolvable code* which is the URL encoded in the bar code (FF 7). That response, we find, is the *accessing with the first computer* (client system) a *second computer* (DNS server) *disposed on the network in accordance with routing information provided by the first computer* (FF 5) and *transferring to the second computer from the first computer at least the software identification code* (FF 6). (In DNS resolution, the message sent to the DNS server also contains the URL of the remote server, which is the subject of claim 13.)

We further find that one of ordinary skill in the art would know that the DNS server stores additional IP addresses (*software identification codes*) that correlate to URL system addresses of *one of more remote locations* such that the URL is “resolved” into *routing information* (IP addresses) so that the first computer can reach the *remote locations* (FF 10). The table of URL/domain names and IP addresses stored and consulted at the DNS server is the very purpose of the DNS system. We find that the DNS server receives the request from the *first computer* (FF 4), and in checking the TCP/IP message destination address with its own records to determine that it

is the recipient of the message, the DNS server performs *a lookup operation at the second computer to match the software identification code with a remote location* (that is that DNS server)¹, so that the DNS server may *obtain associated remote routing information*. We find that the DNS server returns the IP address/*routing information* in the DNS request to the *first computer* which corresponds to the *software identification code* (address of the DNS server in the DNS request message of a URL to resolve) for the *remote location* such that the *first computer* can *access the remote location* corresponding to the URL address sent for resolving, using the returned IP address (FF 4). We therefore find that one of ordinary skill in the art would recognize that Wilz, Sr. discloses the common practice of requesting an IP address for a URL (from the scanned bar code) from a DNS server, thus meeting the claim language as to *routing information*.

We accept as our own the Examiner's findings as to claims 2, 4-8, 11-16, 18, 20-24, and 27-36 (FF 8), rejected under Section 102(e), about which Appellant does not present argument. Using those findings, we enter new a rejection of those claims under 35 U.S.C. § 103(a) because a disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for anticipation is the "epitome of obviousness." *In re Pearson*, 494 F.2d 1399, 1402 (CCPA 1974).

Claims 3 and 19

Dependent claim 3 recites, in pertinent part, *wherein in response to the sensing of a machine-resolvable code using the input device, the*

¹ We find that the *remote location* associated with the *software identification code* cannot be the same *remote location* associated with the *machine resolvable code* because that would mean those two codes would then fail to be *unrelated*, as required.

software application running on the first computer converts the software identification code and generates routing information for transmission to the second computer. Claim 19, which depends from independent claim 17, recites essentially the same limitation.

We enter a new grounds of rejection of claims 3 and 19 under 35 U.S.C. § 103(a) over Wilz, Sr., because we find, as set forth above, that in the use of TCP/IP protocols and Domain Names in Wilz, Sr., one of ordinary skill in the art would understand this would most commonly employ the use of a stored DNS server IP address (FF 5). We further find one of ordinary skill in the art would understand that the client/*first computer* in Wilz, Sr. converts the address to the destination address of a TCP/IP message to the DNS server, requesting the DNS server resolve a URL into an IP address (FF 6), thus meeting the claim requirements.

Claims 9 and 25

Dependent claims 9 and 25 recite, in pertinent part, *wherein the optical code is a portion of a display screen displaying a pattern of modulated brightness and the optical code scanner comprises a light sensor.*

We enter a new grounds of rejection of claims 9 and 25 under 35 U.S.C. § 103(a) over Wilz, Sr., because we find one of ordinary skill in the art would recognize that that a bar code displayed on paper and read by a bar code reader is essentially the same as a bar code displayed on a *display screen* and read by a bar code reader, because each serve the same function with the same displayed patterns of encoded information. Therefore we find no functional difference between reading a bar code from either medium, and find the disclosure in Wilz, Sr. of a bar code reader to read encoded bar code symbols (FF 7) meets the claim requirements.

Claims 10 and 26

Dependent claims 10 and 26 recite, in pertinent part, *wherein the machine-resolvable code is an audio tone and the input device comprises a microphone.*

We enter a new grounds of rejection of claims 10 and 26 under 35 U.S.C. § 103(a) over Wilz, Sr., because we find that Wilz, Sr. discloses the use of speech recognition “so that the user can enter information to the Internet browser by speaking rather than through manual keystroke” (FF 9), and find that such speech encodes the URL and is thus a *machine-resolvable code* in the form of an *audio tone*, thereby meeting the claim language.

CONCLUSIONS OF LAW

The Examiner erred in rejecting claims 1-36 under 35 U.S.C. § 102(e) over Wilz, Sr.

We enter a new ground of rejection under 35 U.S.C. § 103(a) over Wilz, Sr. of claims 1-36.

DECISION

For the above reasons, the Examiner’s rejection of claims 1-36 is REVERSED.

We enter a new ground of rejection under 35 U.S.C. § 103(a) over Wilz, Sr. of claims 1-36.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b) (2008). 37 C.F.R. § 41.50(b) provides “[a] new ground of

rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

Appeal 2009-015272
Application 10/791,678

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED; 37 C.F.R. § 41.50(b)

Klh